

04-17-02

GP 3738

1

MPI 8311  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Richard Ornberg et al.

Art Unit 3738

Serial No. 09/580,007

Filed May 26, 2000

Confirmation No. 9935

For BIOMATERIALS MODIFIED WITH SUPEROXIDE DISMUTASE MIMICS

Examiner David J. Isabella

April 16, 2002

RESPONSE TO RESTRICTION REQUIREMENT

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action of April 2, 2002, in which an election of claims between Group I, drawn to claims 1-63, Group II, directed toward claims 64-186, Group III, drawn to claims 187-194, and Group IV, directed toward claims 195-196, for prosecution on the merits was requested. In addition, an election of species was requested if either Group II or Group III are elected.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made **without serious burden**, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."<sup>1</sup>

In this case, restriction is not proper. The claims of Group I, Group II, Group III and Group IV are drawn to a biomaterial modified with a catalyst for the dismutation of superoxide, to a process for modifying a biomaterial with a catalyst for the dismutation of superoxide, to a biocompatible article modified with a catalyst for the dismutation of superoxide, and to an intermediate compound employed in the process of making a catalyst for the dismutation of superoxide, respectively. Each of the claims of Group I, II, III and IV,

---

<sup>1</sup> MPEP § 803 (emphasis added).

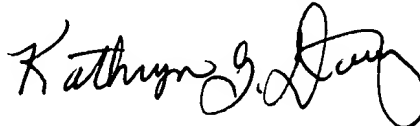
T.H.  
4-24-02  
#5/ElectrRECEIVED  
APR 22 2002  
103700 MAIL ROOM

accordingly, share in common a catalyst for the dismutation of superoxide. Any search of the prior art and examination involving Group I claims, therefore, will necessarily co-extend with the search and examination of Group II, Group III, and Group IV claims. Moreover, the prior art regarding catalysts for the dismutation of superoxide is sufficiently sparse to allow the examination of these claims without undue burden. Thus, as the examination of the entire application may be made without serious burden, the claims of Groups I, II, III and IV should be examined together in accordance with MPEP § 803.

Applicants, subject to the foregoing traverse, hereby elect to prosecute the claims of Group I, claims 1-63, drawn to a biomaterial.

Moreover, Applicants reserve the right to file divisional applications directed to the subject matter of the non-elected claims.

Respectfully submitted,



Kathryn J. Doty, Reg. No. 40,593  
SENNIGER, POWERS, LEAVITT & ROEDEL  
One Metropolitan Square, 16th Floor  
St. Louis, Missouri 63102  
(314) 231-5400

KJDMkd

Express Mail No. EL937979506US  
Box Non-Fee Amendments